

REMARKS

The Official Action of September 28, 2006, and the prior art cited and relied upon therein have been carefully studied. The claims in the application are now claims 1-7 and 10-22, and these claims define patentable subject matter warranting their allowance. The applicants therefore respectfully request favorable reconsideration and allowance.

Acknowledgement by the PTO of the receipt of applicants' papers filed under Section 119 is noted. For the record, however, PCT/EP03/08729 is **not** a parent application; the present application is the U.S. National Phase of PCT/EP03/008729, i.e. they are the **same** application.

Applicants understand from the bottom two thirds of page 2 of the Official Action that claims 1, 6-16 and 18 have been rejected under the second paragraph of §112, although there is no specifically stated rejection. Such implied rejection is respectfully traversed.

As regards claim 1, the phrase "or the like" has been deleted. Claim 6 has been amended to make it dependent on claim 5, thereby providing proper antecedent basis.

As regards claim 7, applicants believe that "encapsulation" is clearly the same as "substrate-enclosing", and therefore antecedent basis did exist. Nevertheless, in deference

to the examiner's views, an appropriate cosmetic amendment has been made in claim 7.

With regard to claims 8-16 and 18, applicants also believe that the antecedent basis was clear in that the metallic substrate is the same as the core. Nevertheless, in deference to the examiner's views, appropriate amendments have been made to make the antecedent basis even more clear.

Applicants respectfully note for the record that antecedent basis need not be exact, only sufficient so that the scope of the claim is reasonable ascertainable, noting MPEP 2173.05(e), citing *Ex parte Porter*, 25 USPQ 1144, 1145 (BPAI 1992).

Withdrawal of the rejection is in order and is respectfully requested.

As no other rejections have been imposed under §112, applicants understand that their claims are otherwise deemed by the PTO to be in full conformance with §112, and applicants are proceeding in reliance thereof.

Claims 1-5, 8, 16, 19 and 20 have been rejected under §102 as anticipated by Reisser et al USP 5,931,996 (Reisser). This rejection is respectfully traversed.

Reisser shows colored aluminum pigments and process for producing same, which pigments may be used for a variety of purposes, including cosmetic preparations. However, cosmetics come in contact with the skin, and therefore toxicity problems

inherently exist with respect to such pigments. The problem is particularly important with respect to lipstick in view of the potential for the pigments to become ingested.

The examiner has recognized that Reisser does not disclose the features of claim 9, such features now being incorporated into claim 1. Accordingly, claim 1 and all the claims which depend therefrom, including claims 2-5, 16, 19 and 20, clearly define novel subject matter over Reisser, whereby applicants need not further address this rejection at the present time.

Withdrawal of the rejection is in order and is respectfully requested.

Claims 1, 2 and 5-15 have been rejected as anticipated by Suzuki et al USP 5,718,753 (Suzuki). This rejection is respectfully traversed.

Suzuki, like Reisser, discloses colored metallic pigments comprising any of aluminum, bronze, copper, silver and gold as the core or substrate, but preferably aluminum. Such pigment cores are provided with "a very fine, substantially continuous, uniform and homogeneous layer of organic pigment particles... directly in contact with the metallic core." The coating is provided by vacuum evaporation or plasma coating (column 10, and examples).

The PTO admits that Suzuki does not even mention purity, "so we assume the metals are pure," Applicants

respectfully protest. All metals contain some impurities, so it is not valid to assume that the metals used by Suzuki and disclosed therein are pure. An anticipation rejection, i.e. one based on what the reference does not disclose is normally not proper, i.e. silence in a reference is no basis for a rejection. Inherency must be certain or inevitable, *In re Brink*, 164 USPQ 247.

Moreover, all of applicants' claims, even as originally presented, require that the substrate-enclosing layer be "produced by the sol-gel process, . . ." This is an important **product** distinction, because the obtained layer is then free of additional and potentially undesirable ions such as chlorides and sulfates because, compared to other coating methods, the sol-gel process requires no pre-treatment to activate or degrease the core or substrate which is coated with auxiliary grinding agents. Additionally, a layer obtained by the sol-gel method, because it is obtained from monomeric pre-stages, offers the advantage of a particularly even, dense and therefore high-quality, optically not perceptible layer, which is additionally harmless from health-related and hygienic points of view, particularly important for cosmetic applications (see bottom paragraph on page 3 of applicants' specification).

Suzuki does not anticipate any of applicants' claims. Therefore, withdrawal of the rejection is in order and is respectfully requested.

Claims 1 and 18 have been rejected under §102 as anticipated by Souma et al USP 5,213,618 (Souma). This rejection is respectfully traversed.

First, many of the points made above apply equally to Souma, and are therefore respectfully repeated by reference.

However, claim 9 has now been incorporated into claim 1 as noted above. Claim 9 was not rejected as anticipated by Souma, and therefore this rejection need not be further addressed at the present time.

Withdrawal of the rejection is in order and is respectfully requested.

Claim 17 has been rejected as obvious under §103 from Reisser in view of Nadkarni et al WO 95/14732 (Nadkarni). This rejection is respectfully traversed.

Nadkarni has not been cited to make up for the deficiencies of Reisser as pointed out above, and indeed does not do so. Therefore, even if the combination were obvious, the reconstructed Reisser (in view of Nadkarni) would not reach claim 1, let alone claim 17 which incorporates the subject matter of claim 1.

Withdrawal of the rejection is in order and is respectfully requested.

Two new claims 21 and 22 have been added. These two new claims are based on original claims 5 and 6, and are

patentable for the same reasons as the claims from which they depend.

The prior art documents made of record and not relied upon by the PTO have been noted, along with the implication that such documents are deemed by the PTO to be insufficiently material to warrant their application against any of applicants' claims.

Applicants believe that all issues raised in the Official Action have been addressed above in a manner that should lead to patentability of the present application. Favorable consideration and early formal allowance are respectfully requested.

Respectfully submitted,

BROWDY AND NEIMARK, P.L.L.C.
Attorneys for Applicant

By



Sheridan Neimark
Registration No. 20,520

SN:kg
Telephone No.: (202) 628-5197
Facsimile No.: (202) 737-3528
G:\BN\R\rau\kaupp1\pto\2007-02-28_PCTAMD.doc